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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/604,001 06/26/00 HOSSEL

F 50105

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HM12/1017

EXAMINER

FUBARA, B

ART UNIT

PAPER NUMBER

1615

DATE MAILED:

10/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

09/604,001

Applicant(s)

HOSSEL ET AL.

Examiner

Blessing M. Fubara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Examiner acknowledges receipt of paper number 7 filed 8/1/01. In paper number 7 filed 8/1/01 applicants requested reconsideration of the claims and no amendment to the claims was presented in the paper number 7.

Applicants in generic claim 1 claim a composition comprising at least one copolymer comprising items 1a and 1e. Items 1b to 1d range in amounts from 0-98.99 and thus the items 1b to 1d are not critical in the composition. The future intended use of a composition does not distinguish over the prior art that teaches the claimed composition.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

### ***Claim Rejections - 35 USC § 102***

1. Claims 1 and 3-10 remain rejected under 35 U.S.C. 102(e) as being anticipated by Tropsch et al. (US 5,869,032).
2. Applicants traversed this rejection on the basis that the cross-linker in the present application is derived from acrylic or methacrylic esters of at least dihydric alcohols and that the monomers of Tropsch do not refer to esters of at least dihydric alcohols. However, Tropsch in

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column 2, lines 50-52 teaches hydroxyalkyl (meth) acrylates or alkylethylene glycol (meth) acrylates that have 1-50 ethylene glycol units in the monomeric unit. Glycol is a dihydric alcohol.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Tropsch discloses a polymeric preparation that can be used in cosmetic compositions such as liquid soaps, body lotions, aftershaves, face lotion and other liquid formulation for skin. The polymeric preparation of Tropsch comprises 1-vinylimidazole, quaternized 1-vinylimidazole, N-vinylcaprolactam, N-vinylpyrrolidone, 3-methyl-1-vinylimidazolium methylsulfate, 2,2'-azobis(2-amidinopropane) dihydrochloride and polymerization of the preparation takes place by free radical polymerization. Furthermore, the preparation contains perfume oils, emulsifiers, preservatives, collagen and vitamins. The composition of Tropsch et al. further comprises monomers selected from the group consisting of C<sub>1</sub>-C<sub>12</sub>-esters of acrylic or methacrylic acid, acrylamides and methacrylamides. See abstract, columns 1-4, formulations 1-10 and claims 1, 2, and 11-13. Monomers of acrylic and methacrylic esters are capable of acting as crosslinkers (compare page 8, lines 8-10 of applicants' specification). Tropsch in column 2, lines 50-52 teaches hydroxyalkyl (meth) acrylates or alkylethylene glycol (meth) acrylates that

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have 1-50 ethylene glycol units in the monomeric unit. Glycol is a dihydric alcohol. Thus, the teachings of Tropsch meet the limitations of the claims.

3. Claims 1-5 and 11 were rejected under 35 U.S.C. 102(e) as being anticipated by Uhl et al. (US 5,219,969). This rejection is not maintained but rather claims 1-5 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Uhl et al. (US 5,219,969). Applicants traversed the rejection on the grounds that Uhl teaches thickeners for textile print pates. But future intended use is not critical in a composition claim and does not distinguish the invention over the composition of the prior art.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Uhl et al. (US 5,219,969).

Uhl discloses water-in-oil emulsion and oil-in-water emulsion polymeric preparation wherein the preparation comprises divinylethyleneurea, N-vinylimidazole and 2, 2'-azobis (2-amidinopropane) dihydrochloride, and the polymerization of the monomers takes place by free radical process (abstract, column 4, lines 11-65, columns 9 and 10 and claims 1-5). Future intended use is not critical in a composition claim. The teachings of Uhl et al. meet the limitations of the claims.

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***Claim Rejections - 35 USC § 103***

6. Claims 1-13 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Tropsch et al. (US 5,869,032) and Uhl et al. (US 5,219,969). Applicants agree that there is no suggestion to combine Tropsch and Uhl, and state, assuming *arguendo*, that the comparative test data at pages 26-27 of the specification disapproves any presumption of obviousness. The comparative data of pages 26-27 of the specification does not refer to the composition of Uhl. The compositions of Uhl and Tropsch both contain monomers that are capable of acting as crosslinkers. The motivation to combine stems from the teachings of the prior art references. Both references teach polymeric preparations that comprise monomers that are capable of acting as crosslinkers. The utility in Tropsch is directed to cosmetics and the utility in Uhl is directed to thickeners for textile. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

The teachings of Tropsch is described under 35 U.S.C. 102(e). The teaching of Uhl et al. is described under 35 U.S.C. 102(b). Although, both Tropsch and Uhl disclose free radical polymerization of monomers wherein the polymeric preparation is used in cosmetic formulation, Tropsch et al. is silent about water-in-oil or oil-in-water emulsion, Uhl et al. teaches a water-in-oil and an oil-in-water emulsions. Furthermore, Tropsch et al. discloses a polymeric preparation that can be used in cosmetic compositions such as liquid soaps, body lotions, aftershaves, face lotion and other liquid formulation for skin. One of ordinary skill in the art knows that emulsions are utilized in cosmetic formulations/compositions. The expected result from the teachings of Tropsch and Uhl is a polymeric preparation comprising divinylethyleneurea, N-

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vinylimidazole and 2, 2'-azobis (2-amidinopropane) dihydrochloride, quaternized 1-vinylimidazole, N-vinylcaprolactam, N-vinylpyrrolidone, 3-methyl-1-vinylimidazolium methylsulfate wherein the polymer is formed by polymerization of the monomers by a free radical process. The expected result is a water-in-oil emulsion and oil-in-water emulsion for skin cosmetics. The composition of Tropsch comprises monomers capable of cross-linking and it is not necessary to substitute the copolymer of Uhl for the copolymer of. Formulations comprising water-in-oil emulsion and/or oil-in-water emulsion are known in the art to be employed in the formulations of cosmetics.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Tropsch and Uhl. One having ordinary skill in the art would have been motivated to prepare water-in-oil or oil-in-water emulsion wherein the emulsion comprises polymeric preparation comprising divinylethyleneurea, N-vinylimidazole and 2, 2'-azobis (2-amidinopropane) dihydrochloride, quaternized 1-vinylimidazole, N-vinylcaprolactam, N-vinylpyrrolidone and 3-methyl-1-vinylimidazolium methylsulfate. Whereas Tropsch teaches 5-5% by weight of the imidazole and Uhl teaches 0-49% by weight of triallylamines, the 1-99.9% by weight of N-vinylimidazoles or diallylamines of the instant invention is not inventive over the prior arts without a showing.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-13 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 5,869,032 (Tropsch et al.) in view of Uhl et al. (US Patent No. 5,219,969). Both Tropsch and Uhl disclose free radical polymerization of monomers wherein the polymeric preparation is used in cosmetic formulation. Uhl teaches a water-in-oil and oil-in-water-emulsions. Thus, combining the teachings of both prior art references would enable one of ordinary skill in the art to formulate water-in-oil or oil-in-water cosmetic product comprising the copolymeric composition of Tropsch. It would have been obvious to one of ordinary skill in the art, having the common knowledge that emulsions are utilized in cosmetic compositions, to formulate the composition of Tropsch as a water-in-oil or oil-in-water emulsion in the manner taught by Uhl.



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Applicants agree that there is suggestion to combine the two references and thus no terminal disclosure is necessary. The rejection is proper as stated in the discussion above, and thus a terminal disclaimer would be necessary to overcome this rejection.

**Suggestion:** It is suggested that abbreviations W/O and O/W in claims 10 and 11 be replaced with water-in-oil or oil-in-water.

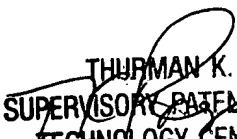
9. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is requested in correcting any errors of which applicants may become aware in the specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is 703-308-8374. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Blessing Fubara  
October 14, 2001

  
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